

REMARKS

At the time of the Final Office Action dated April 22, 2005, claims 4, 7, 13-15, and 18-20 were pending in this application. Of those, claims 7, 15, and 20 have been rejected. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 4, 13-14, and 18-19.

APPLICANTS REQUEST WITHDRAWAL OF THE FINALITY OF THE PRESENT

OFFICE ACTION

Applicants submit that the present Office Action dated April 30, 2003, has improperly been designated as final. In the statement of the rejection, the Examiner cited M.P.E.P. § 706.07(a) as the basis for making the present Office Action final and stated: "Applicant's [sic] amendment necessitated the new ground(s) of rejection presented in this Office action." However, M.P.E.P. § 706.07(a) clearly states:

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. (emphasis added)

In the Office Action dated September 10, 2004, the Examiner rejected dependent claim 7 under 35 U.S.C. § 102 for anticipation based upon Beason et al. In the Amendment filed December 10, 2004, dependent claim 7 was only amended to be placed in independent form. Therefore, the amendment to claim 7 does not raise any new issues, and claim 7 is deemed not amended. However, in the present Office Action, claim 7 is

rejected under 35 U.S.C. § 103 for obviousness based upon Beason in view of Chinoy et al.. Thus, the Examiner has rejected claim 7, which was not amended, on newly cited art (i.e., Chinoy et al.). Therefore, it is improper under M.P.E.P. § 706.07(a) for the Examiner to designate the present Office Action as final. On this basis, Applicants respectfully solicit withdrawal of the finality of the present Office Action.

**CLAIM 7 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
BEASON ET AL., U.S. PATENT NO. 6,373,430 (HEREINAFTER BEASON), IN VIEW OF
CHINOY ET AL., U.S. PATENT NO. 6,771,969 (HEREINAFTER CHINOY)**

On pages 2 and 3 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the personal radio service device of Beason in view of Chinoy to arrive at the claimed invention. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner has failed to discharge the initial burden of establishing a prima facie basis to deny patentability to the claimed invention under 35 U.S.C. § 103.¹ The obviousness of a particular combination in hindsight or the ease in which a particular combination can be made is not the test for rejecting a claim under 35 U.S.C. § 103. As a general matter, "virtually all [inventions] are combinations

¹ In re Mayne, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to identify a source in the applied prior art for: (1) claim limitations; and (2) the motivation to combine references or modify a reference in the reasonable expectation of achieving a particular benefit. Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999).

of old elements."² For this reason, the Examiner has the burden of establishing a realistic motivation to modify the personal radio service (PRS) device of Beason to include a visual display for displaying a bearing and range of another PRS device, as allegedly taught by Chinoy.³ Furthermore, the source for the motivation to combine the references must be found within the applied prior art, and it is legally improper for the Examiner to assert a motivation to combine that is not supported by the applied prior art.⁴

The Examiner's asserted motivation to modify Beason in view of Chinoy is as follows:

Therefore, since a from location information, range and bearing would have been easily calculated, so it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Beason's reference with the teaching of Chinoy, so that the location information of another personal radio would have been comprised range and bearing, because such modification would have clarified the teaching of Beason, and would have enabled users to precisely location [sic] each other.

Essentially, the Examiner has asserted that the motivation to combine is to "[clarify] the teaching of Beason" and the combination would enable "users to precisely location [sic] each other." However, upon reviewing Chinoy, it is apparent that the Examiner's asserted motivation to combine cannot be found in the teachings of Chinoy. Thus, the Examiner

² In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).

³ The requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art to combine specific references to arrive at a specifically claimed invention. In re Deuel, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); In re Newell, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). The mere identification of claim features in disparate references does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

⁴ Smiths Industries Medical System v. Vital Signs Inc., *supra*; In re Mayne, *supra*.

has failed to establish a proper motivation to modify Beason in view of Chinoy so as to arrive at the claimed invention.

Applicants also note that the Examiner has not established that the applied prior art teaches a realistic benefit that would be achieved by the proposed combination. As stated by Beason in column 4, lines 54-56, "the other members of the group could quickly locate a member who becomes lost or injured." Thus, Beason already asserts that users are capable of precisely locating each other. Therefore, based upon Beason's disclosure, the prior art has not establish a problem needing to be solved with users precisely locating each other.

Furthermore, the Examiner's secondary reference of Chinoy does not state that Beason's system could be improved by including bearing and range information. Instead, Chinoy is directed to a very different type of system. The system disclosed by Chinoy includes a central computer 22 that keeps track of multiple vehicles 24 (see Fig. 1). Furthermore, although Chinoy discusses displaying bearing and range information, this information is only displayed on the computer display 40 of the central system, and there is no apparent disclosure within Chinoy that the bearing and range information is displayed on any display within the vehicles 24. Therefore, not only does Beason teach a problem with users precisely locating each other, Chinoy does not appear to teach allowing "users to precisely location [sic] each other" by providing each user of a personal radio service device with bearing and range information. Thus, Applicants

submit that the Examiner has asserted a factually unsupported motivation to modify Beason in view of Chinoy.

For the reasons stated above, Applicants submit that one having ordinary skill in the art would not have arrived at the claimed invention based upon the teachings of Beason and Chinoy. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claim 7 under 35 U.S.C. § 103 for obviousness based upon Beason in view of Chinoy.

**CLAIMS 15 AND 20 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON BEASON IN VIEW OF MIYASAKA ET AL., U.S. PATENT PUBLICATION NO.
2001/0018635 (HEREINAFTER MIYASAKA)**

On pages 3-5 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the methodology of Beason in view of Miyasaka to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 15 and 20 each recite: "encoding said positioning data using a privacy code prior to said transmission, said privacy code restricting access to said positioning data by other PRS devices." As admitted by the Examiner, this limitation is neither taught nor suggested by Beason. On pages 4 and 5 of the Office Action, the Examiner stated the following:

However, Miyasaka discloses a radio data communication apparatus in figure 1. Miyasaka teaches encoding data with an encrypting key (private code) (paragraph 0055-0057).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Beason's reference with the teaching of Miyasaka, so that the location information would have been encoded (encrypted) before transmission, because such modification would have provided a secured data communications.

Notwithstanding the Examiner's assertions about what Miyasaka teaches, Applicants note that Miyasaka fails to teach a PRS device encrypting positioning data that will be sent to another PRS device. Furthermore, it is noted that there is no mention within Miyasaka that the encoding of the data allows the position data to be read by at least one other PRS device while restricting access to the positioning data by other PRS devices. Instead, Miyasaka merely teaches the general encryption of data from a car navigation device within a vehicle to a contents stand (server) 41 set outside the vehicle. Even *assuming arguendo* that the contents stand (server) 41 of Miyasaka could be considered comparable to the claimed PRS device, Miyasaka fails to state that only certain contents stands (server) 41 can access the positioning data whereas others cannot.

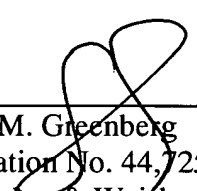
Thus, even if one having ordinary skill in the art were motivated to motivated to modify Beason in view of Miyasaka, the claimed invention would not result. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 15 and 20 under 35 U.S.C. § 103 for obviousness based upon Beason in view of Miyasaka.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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